

REMARKS

By this Amendment, Applicants amend claims 1 and 6 to more appropriately define the invention. With claims 2-4 and 7-9 having been previously canceled, claims 1, 5, 6, and 10 are pending.

In the final Office Action of October 27, 2003¹, claims 1, 5, 6, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,793,336 to *Mano et al.* ("*Mano*") in view of U.S. Patent No. 6,288,716 to *Humpleman et al.* ("*Humpleman*"). Applicants submit that the rejection should be withdrawn for the reasons discussed below.

A *prima facie* case of obviousness has not been established with respect to claims 1, 5, 6, and 10. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

Claim 1 recites a combination including:

display means for displaying discrimination information for discriminating the communication devices selected by said selection means, wherein a user is capable of selecting, using the displayed discrimination information, one or more of the communication devices for executing an application; and

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

application execution instruction sending means for sending instruction information for executing the application to the one or more communication devices selected for executing the application.

Mano fails to teach or suggest at least the above-noted features. *Mano* is directed to a graphical display that “displays graphical images representing devices coupled to a bus” (Abstract). *Mano* discloses that “when a device is added to [a]...serial bus, a graphical image representing that device is automatically displayed” (Abstract). According to *Mano*, “[t]asks preformed by the devices coupled to the serial bus are...controlled and monitored by the user” via the display (Abstract). *Mano* does not teach or suggest at least displaying discrimination information for discriminating communication devices selected by said selection means, wherein a user is capable of selecting, using the displayed discrimination information, one or more of the communication devices for executing an application, as claimed. Instead, *Mano* merely describes displaying all devices attached to a bus and that a user can select certain tasks. Displaying all attached devices and allowing a user to select tasks, as mentioned by *Mano*, is not the same as selecting from the attached devices those that can provide a designated service, displaying discrimination information for discriminating those selected devices, and selecting, by a user, one or more of the devices for executing an application using the discrimination information, as recited in claim 1.

Moreover, *Mano* fails to teach or suggest “application execution instruction sending means for sending instruction information for executing the application to the one or more communication devices selected for executing the application,” as claimed. In fact, the Examiner concedes (Office Action, page 3) that *Mano* fails to disclose “application execution instruction sending means.” *Mano*, therefore, fails to teach each and every element recited in claim 1.

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Humpleman fails to cure *Mano*'s deficiencies. *Humpleman* describes a system for "commanding and controlling diverse home devices" (Abstract). *Humpleman* describes a "session manager [that]...allows users to command and control the home devices that are connected to the home network" (col. 14, lines 27-33). According to *Humpleman*, the session manager "obtains the particular capabilities of a [user-]selected home device" and "continues to activate the respective device button" for devices "having a matching capability to the selected home device" (col. 15, lines 13-31). For each device not having a matching capability, the session manager sets the respective button as non-responsive to user selection (col. 15, lines 31-36).

In contrast, claim 1 recites "displaying discrimination information for discriminating the communication devices selected by said selection means, wherein a user is capable of selecting, using the displayed discrimination information, one or more of the communication devices for executing an application." *Humpleman* does not disclose such features. Instead, *Humpleman* mentions deactivating devices which do not match a device selected by a user. Deactivating non-matching devices, as described by *Humpleman*, is not the same as selecting from the attached devices those that can provide a designated service, displaying discrimination information for discriminating those selected devices, and selecting, by a user, one or more of the devices for executing an application using the discrimination information, as recited in claim 1.

Humpleman further fails to teach or suggest "application execution instruction sending means for sending instruction information for executing the application to the one or more communication devices selected for executing the application," as claimed. *Humpleman*, therefore, cures *Mano*'s deficiencies.

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Accordingly, neither *Mano* nor *Humpleman*, nor any combination thereof, teaches or suggests each and every element recited in claim 1. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claim 1.

Even if *Humpleman* could cure all of *Mano*'s deficiencies—which the Office Action has not established and to which Applicants do not acquiesce—a *prima facie* case of obviousness has not been established with respect to claim 1 at least because there is no motivation to combine the references. Applicants submit that a skilled artisan having *Mano* before him would not have been motivated to combine *Humpleman* with the *Mano* system in a manner resulting in Applicants' claimed combination. Applicants remind the Examiner that determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

The Office Action alleges (page 4) that it would have been obvious to "combine the teachings of [*Mano*]...with the teachings of [*Humpleman*]...in order to facilitate the commanding and controlling of a plurality of devices." This statement does not show a "clear and particular" motivation to combine the references. Applicants submit that a skilled artisan having *Mano* before him would not have been motivated to combine *Humpleman* with the *Mano* system to "to facilitate the commanding and controlling of a plurality of devices," as the *Mano* system already facilitates the "control...of devices coupled to the ...network" (col. 4, lines 20-22), and nothing would be gained by the combination.

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For at least the foregoing reasons, a *prima facie* case of obviousness has not been established with respect to claim 1. Applicants, therefore, deem claim 1 patentable over the relied-upon prior art.

Similar to claim 1, independent claim 6 recites, *inter alia*:

displaying discrimination information for discriminating the selected communication devices;

selecting, using the displayed discrimination information, one or more of the communication devices for executing an application; and

sending instruction information for executing the application to the communications devices selected for executing the application.

For at least the reasons presented above in connection with claim 1, a *prima facie* case of obviousness has not been established with respect to claim 6. Applicants, therefore, deem claim 6 patentable over the relied-upon prior art.

Claim 5 depends from allowable base claim 1, and claim 10 depends from allowable base claim 6. Claims 5 and 10 are allowable for at least the same reasons presented above in connection with base claims 1 and 6, respectively. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of the pending claims.

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In view of the foregoing, Applicants request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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